

new questions of patentability arise by this amendment and no questions of new matter arise. Therefore, entry of the amendment and consideration of the following remarks are respectfully requested.

Claims 7-21, 31-33, and 37-53 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Nelson (U.S. Patent No. 6,324,809 B1) in view of Spain et al. (U.S. Patent No. 5,662,977) and further in view of Andres (U.S. Patent No. 5,553,427). The Examiner asserts that Nelson shows planks which can be used to form a floating floor. The Examiner further points out that this floor can have a core layer which may be polyvinylchloride and has a decorative overlay, which may be a high-pressure laminate. The Examiner takes the position that many options for the top and bottom layers of the core are taught, and further asserts that the core being exposed at the bottom surface with a decorative laminate as the top surface is "a possible taught option." The Examiner cites column 2, lines 50-61, of Nelson for this argument. The Examiner asserts that Spain et al. shows a transfer printed color layer with a protective coating used to decorate a polyvinylchloride layer. Furthermore, the Examiner relies on Andres to show the use of hollow cavities in a polyvinylchloride floor plank, as well as the use of feet to raise the plank off the floor. The Examiner asserts that it would have been obvious for one of ordinary skill in the art to use a transfer print layer as shown in Spain et al. on the plank of Nelson instead of a printed overlay. Further, the Examiner asserts that it would have been obvious to use cavities and feet in the planks of Nelson in view of Andres in order to lower the weight and amount of material used in the core and to raise the planks off of the sub-floor. It is further asserted by the Examiner that Nelson explicitly and implicitly shows rectangular planks with no type of cupping, and therefore Nelson, as

modified by Spain et al. and Andres, is equivalent to the planks of the present application. For at least the following reasons, the applicants respectfully traverse the rejection.

The applicants note the independent claims under consideration are claims 31, 47, 51 and 53. Claim 31 is directed to a thermoplastic plank having a core comprising at least one thermoplastic material, a printed design on the top surface of the plank, and at least one protective coating on top of the printed design. Claim 47 is directed to a floor covering forming a floating surface, wherein the floor covering has a plurality of thermoplastic planks, and each plank has a core comprising at least one thermoplastic material, a printed design on the top surface of the core, and a protective layer on top of the printed design. Claim 51 is directed to a plank as in claim 31, wherein no backing layer is adjacent a bottom surface of the core. Claim 53 is directed to a plank as in claim 31, wherein at least a bottom surface of the core is thermally treated.

One of ordinary skill in the art would not be motivated to combine the teachings of Nelson, Spain et al, and Andres to arrive at the claimed invention as set forth in claims 7-21, 31-33, and 37-53, and could not combine the different structures. Nelson teaches a core for use in laminate floorings which does not include a printed design on the top surface. Nelson requires a laminate on the top and on the bottom. Spain et al. is directed to the transfer of an image from a film to an extruded sheet. Spain et al. is not directed to direct printing of an image on a core or plank. Andres is not a laminate involving a print layer or protective layer, and therefore also cannot be used to modify Nelson to achieve the claimed invention. Andres is a siding with a completely different design. Thus, there is no teaching or motivation to modify Nelson to include a print layer and a protective coating. One of ordinary skill in the art would have to use hindsight to pick and choose the various parts of the secondary references and place them on Nelson. This clearly is not the

standard for a rejection under 35 U.S.C. 103(a), and none of the references provide motivation for the Examiner to pick and apply such features. Therefore, none of the references, taken alone or in combination, teach or disclose the subject matter of the claimed invention.

Even if one were to combine the references of Nelson, Spain et al., and Andres, one skilled in the art would not arrive at the claimed invention. Nelson relates to a surface covering for laminate floorings. However, contrary to the Examiner's arguments, Nelson does not teach or suggest a protective layer affixed to a top surface of a print layer that is affixed to a top surface of a core, as set forth in claim 1 of the above-identified application. Nelson relates to the use of a decorative laminate on top of a core. In contrast, the claimed invention, as exemplified by independent claim 31, relates to a print done directly on the top surface of the core. Spain et al. relates to a plastic sliding panel for outdoor use, wherein the panel has a printed design transferred from a film onto an extruded sheet. Spain et al., like Nelson, does not teach printing directly on the top surface of a core. Rather, Spain et al. teaches forming a decorative coating on a flexible carrier sheet, and transferring the decorative coating from the carrier sheet to an extruded sheet, as set forth, for example, in the Abstract. Thus, neither Nelson nor Spain et al. teach or suggest a core having a printed design, wherein the design is printed directly on the core, as opposed to transferred or supplied in an additional layer. Andres is not directed to forming a decorative print on a surface, and does not cure the deficiencies of Nelson or Spain et al. Thus, Nelson in view of Spain et al. and further in view of Andres does not teach or suggest at least the subject matter of independent claim 31 and the claims dependent therefrom.

Contrary to the Examiner's assertion, Nelson does not teach or suggest using the surface coverings described therein as a floor covering forming a floating surface, as claimed in

independent claim 47 of the above-identified application.<sup>1</sup> Spain et al. is directed to a different field of art, in particular, plastic siding panels for outdoor use, and thus does not teach or suggest a floating floor. Andres is directed to a plastic extrusion that does not have a base layer, and which can be used as flooring. However, the extrusion of Andres is fixed to a sub-floor, and is not a floating surface as set forth in claim 47 of the above-identified application. Thus, Nelson in view of Spain et al. and further in view of Andres does not teach or suggest at least the subject matter of independent claim 47 and the claims dependent therefrom.

Nelson also does not teach or suggest a plank having a core with a printed design done directly on the top surface of the core, a protective layer affixed to the top surface of the printed design, and no backing layer adjacent the bottom surface of the core, as claimed in independent claim 51 of the above-identified application. As set forth above with regard to claim 31, Nelson does not teach or suggest printing directly on the core. Nelson further does not teach or suggest the absence of a backing layer, contrary to the Examiner's assertions. A review of Nelson as a whole, including the figures and the entire specification, shows that a decorative backing layer, as well as a decorative top layer, are applied to the core of Nelson in all instances. References must be considered in their entirety. The Examiner is not free to pick and choose from among the teachings of a reference, but must consider the teachings of the reference as a whole. In its entirety, Nelson teaches use of a backing layer on the bottom of the core. It is known to one of ordinary skill in the art to place a backing layer on a core to reduce curl and/or warping of a product such as a plank. Products made as known in the art without a backing layer on the bottom layer surface of the core demonstrate an unacceptable curl or warp. Thus, one of ordinary skill in the art would understand

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<sup>1</sup> Applicants note that, unfortunately, the Examiner failed to fully address this argument in the Final Office Action.

Nelson as showing the need to use a backing layer to reduce curl or warp, as known in the art. Spain et al. does not pertain to flooring, and therefore does not impact the teachings of Nelson with regard to use of a backing layer. As discussed with regard to claim 31, Spain et al. does not cure the deficiency of Nelson in that Spain et al. teaches transfer of a decorative layer to a sheet, not direct printing on a core. Andres does not teach a backing layer. As discussed with regard to claim 31, Andres does not cure the deficiencies of Nelson or Spain et al. with regard to application of a decorative layer. Thus, Nelson in view of Spain et al. and further in view of Andres does not teach or suggest at least the subject matter of independent claim 51 and the claims dependent therefrom.

Nelson also does not teach or suggest a plank having a core with a printed design done directly on the top surface of the core, a protective layer affixed to the top surface of the printed design, and wherein at least the bottom surface of the core is thermally treated, as claimed in independent claim 53 of the above-identified application.<sup>2</sup> As set forth above with regard to claim 31, Nelson does not teach or suggest printing directly on the core. Nelson further does not teach or suggest thermal treatment of the core. Spain et al. does not cure the deficiencies of Nelson with regard to printing directly on the core, as discussed above with regard to claim 31, and further does not disclose or suggest thermal treatment of the core. Andres does not cure the deficiencies of Nelson or Spain et al. with regard to printing directly on a core, or to thermal treatment of a core. Thus, Nelson in view of Spain et al. and further in view of Andres does not teach or suggest at least the subject matter of independent claim 53.

Contrary to the Examiner's assertions, Nelson does not implicitly or explicitly state that no cupping of the planks described therein occurs. Should the Examiner choose to rely on his

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<sup>2</sup> Applicants note that, unfortunately, the Examiner failed to address this argument in the Final Office Action.

statement, the applicants again request a showing of where or how Nelson teaches an absence of cupping when it is known to one of ordinary skill in the art that some amount of cupping occurs, particularly at low humidity, when a product does not have a backing layer and/or is not thermally treated. Applicants note this is a second request for clarification and support of the Examiner's argument.

As set forth above, none of the references, taken alone or in combination, teach or suggest the subject matter of the claimed invention. In particular, the references do not teach or suggest a thermoplastic plank having a core comprising at least one thermoplastic material, a printed design on the top surface of the plank, and at least one protective coating on top of the printed design, or a floor covering forming a floating surface made from such planks. Planks as described above having no backing layer adjacent a bottom surface of the core, or wherein at least a bottom surface of the core is thermally treated, are also not taught or suggested. Thus, the applicants submit that all of claims 7-21, 31-33, and 37-53 are in condition for allowance for at least the reasons set forth herein. Prompt consideration and favorable action in the form of a Notice of Allowance are thus respectfully requested.

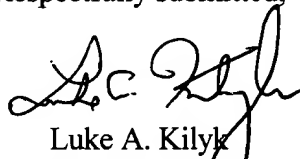
Should there be any question regarding the patentability of the claims, the Examiner is encouraged to contact the undersigned by telephone.

Amendment After Final Rejection  
U.S. Patent Application No. 09/630,121

**CONCLUSION**

If there are any other fees due in connection with the filing of this response, please charge the fees to deposit Account No. 50-0925. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



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